

REMARKS

Claims 1-21 are pending. Claims 1, 2, and 9-21 are rejected and claims 3-8 are objected to. Applicants amend claims 1, 5, and 15 and add new claims 22-33. Applicants also amend the specification and the title.

Specification and Title

The specification and title are objected to. Applicants amend the specification and the title to address the objections and request that the objections be withdrawn.

Claim Objections

Claims 5-8 are objected to because of a lack of antecedent basis for "the second part." Applicants amend claim 5 to depend from claim 3 to provide proper antecedent basis for this feature. Accordingly, Applicants request that this objection to claims 5-8 be withdrawn.

Claims 3-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants add new claims 22-33. Applicants submit that independent claim 22 includes all of the limitations of claims 1, 2, and 3 and is thus allowable. Claims 23-33 depend, directly or indirectly, from claim 22 and are allowable for at least the same reasons.

Claim Rejections Under 35 U.S.C. § 102(b)

Haaga

Claims 1 and 11 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,718,237 ("Haaga"). As amended, claim 1 recites "a stylet having a portion in the housing, the stylet being axially movable between a first extended position and a first retracted position, the stylet being configured such that axial movement of the stylet from the first retracted position to the first extended position causes rotation of the stylet[.]"

Haaga does not describe the claimed stylet. Haaga describes a stylet 16 that is advanced then rotated to take a tissue sample (col. 7, lines 3-11). Therefore, amended claim 1 is not anticipated by Haaga. Claim 11 depends directly from claim 1 and is not anticipated by Haaga for at least the same reason. Accordingly, Applicants request that the rejection of claims 1 and 11 as anticipated by Haaga be withdrawn.

Bachir

Claims 15, 17, 20, and 21 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,660,186 ("Bachir"). Claim 15 recites:

moving a stylet and a stylet block from a first position to a second position, the stylet block having a axially moveable first part and a second part to attached to the stylet, the second part being rotatably engaged with the first part and being able to rotate relative to an axis of the stylet;

simultaneously causing rotation of the stylet along an axis of the stylet by engagement between second part of the stylet block and a housing of the medical instrument; and

Bachir does not describe a method with these steps. Rather, Bachir describes using a handle 44 to rotate a stylet 14/104 (col. 5, line 67 – col. 6, line 4). Therefore, amended claim 15 is not anticipated by Bachir. Claims 17, 20, and 21 depend directly from claim 15 and are not anticipated by Bachir for at least the same reason. Accordingly, Applicants request that the rejection of claims 15, 17, 20, and 21 as anticipated by Bachir be withdrawn.

Claim Rejections Under 35 U.S.C. § 103(a)

Haaga and secondary references

Under 35 U.S.C. § 103(a), claim 2 is rejected as obvious over Haaga in view of U.S. Patent No. 5,146,921 ("Terwilliger"), claims 9 and 10 are rejected as obvious over Haaga in view of U.S. Patent No. 5,989,196 ("Chu"), claims 12 and 14 is rejected as obvious over Haaga in view of U.S. Patent No. 5,921,943 ("Kass"), and claim 13 is rejected as obvious over Haaga in view of U.S. Patent No. 5,394,887 ("Haaga '887"). Claims 2, 9, 10, 12, 13, and 14 depend, directly or indirectly, from claim 1. None of the secondary references remedy the deficiencies of Haaga as discussed above with reference to the rejection of amended claim 1. Therefore, neither Haaga nor the cited secondary references, alone or in any proper combination, provide the basis

for a *prima facie* case of obviousness. Accordingly, Applicants request that the rejection of claims 2, 9, 10, 12, 13, and 14 as obvious over Haaga, alone or in combination with the cited secondary references, be withdrawn.

Bachir and secondary references

Under 35 U.S.C. § 103(a), claim 16 is rejected as obvious over Bachir in view of U.S. Patent No. 5,607,389 ("Edwards"), claim 18 is rejected as obvious over Haaga in view of U.S. Patent No. 5,249,583 ("Mallaby"), and claim 19 is rejected as obvious over Haaga in view of Mallaby and in further view of Haaga '887. Claims 16, 18, and 19 depend, directly or indirectly, from claim 15. None of the secondary references remedy the deficiencies of Bachir as discussed above with reference to the rejection of amended claim 15. Therefore, neither Bachir nor the cited secondary references, alone or in any proper combination, provide the basis for a *prima facie* case of obviousness. Accordingly, Applicants request that the rejection of claims 16, 18, and 19 as obvious over Bachir, alone or in combination with the cited secondary references, be withdrawn.

Conclusion

For at least the foregoing reasons, Applicants respectfully submit that the claims are in condition for allowance.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

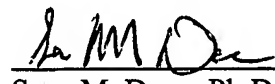
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Enclosed is a \$600 check for excess claims fees and a \$120 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing the attorney docket number shown above.

Respectfully submitted,

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